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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525
5073 7590 01/22/2007 BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER FISCHETTI, JOSEPH A	
			ART UNIT 3627	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/22/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/22/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

09/817,353

Applicant(s)

SIEGEL, PHILIP S.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 35-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/12/03 and 6/25/04 and 9/1/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9,35-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 11, "receiving an electronic selection, by the consumer", is read as the selection is received by the consumer. This makes no sense because if the consumer is participating then should it be said "receiving an electronic selection, generated by the consumer".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7,9,35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Haseltine.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): more specifically, it discloses

1. the customer is identified by the packing slip which he/she bears and thus is automatically associated with the purchased item;

2. transaction history is linked to the bar code packing slip which is gathered when the bar code is read, one of the items of the transaction history which is gathered is statement of the return policy of the e-tailer see, par. 28;

3. regarding the distinction of the step of displaying to a customer, the associate in Haselktine is read as the agent of the customer which inherently is the alter ego of the customer. Also, Inherent to any position in a retail establishment is to allow an employee the use the services of the employer as a benefit of working of a given employer and thus the use could be the customer.

4. the transaction history is displayed on the screen of the computer to which the bar code reader is attached. According to paragraph 28 lines 7 and 8, the product is listed with other information about the transaction and thus answers the "listing" language of claim 1.

5. the item of merchandise selected by the user for return is the one which bears the bar code generated by the e-tailer, and thus is listed within the listing in the transaction history discussed in paragraph 28 lines 7 and 8 of Haseltine. The consumer through its agent 42 is read as a causing a selection to be received by the association server 30 or bureau 44, the selection is read as the item, see, e.g. paragraph [0040], the selection of POKEMAN of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMAN devices for return. Because the selection is inputted into a computer, it is read as an "electronic selection".

6. once the server 30 receives the packing-slip information, it initiates by sending instructions for the return, the returns process.

Re claims 2,3,35,36: retrieving a user preference profile for the consumer is read as - the record on the retailer's site- because somewhere in that record is information which has some preference e.g. which credit card chosen to use versus cash (see par. 0037 for options for refunds).

Re Claim 4: notifying the retailer of the merchandise to be returned (retailer is notified via the associate 42).

Re claim 5: see par.0028 which discloses information yielded by the swiping of slip 26 which includes information on both buyer and seller, retailer return policy and shipper, buyer etc.

RE claim 6 : slip 26 is read as the return shipping label because using it effects the item's return.

Re claim 7: see par. 0039 "such and such shipper" is notified of shipping request for return.

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Re claim 9: see par. 0025 for Internet communication.

RE claim 37: the scanning process which identifies the user is read as the log in process.

Re claim 38: once the bar code is scanned the information is provided in real time.

Re claim 39: the bar code is scanned at the discretion of the owner which is periodic relative to his/her buying patterns.

Re claim 40: the seller in Haseltine is an e-tailer.

Re claim 41: the data in the bar code is read as the identifier.

Re claim 42: the fulfillment process at the point of return place includes an authorization see paragraph 0035.

Re claim 43: instructions are read as the rule see paragraph 0035.

Re claim 44: see col. 0026 cookies vs. boxes determination.

RE claim 45: see label 26.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9,35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine in view of Dodd.

Haseltine discloses a method for processing the local return of remotely purchased merchandise on the WWW (see Par. # 0025): more specifically, it discloses

1. the customer is identified by the packing slip which he/she bears and thus is automatically associated with the purchased item;

2. transaction history is linked to the bar code packing slip which is gathered when the bar code is read, one of the items of the transaction history which is gathered is statement of the return policy of the e-tailer see, par. 28;

3. the transaction history is displayed on the screen of the computer to which the bar code reader is attached. According to paragraph 28 lines 7 and 8, the product is listed with other information about the transaction and thus answers the "listing" language of claim 1.

4. the item of merchandise selected by the user for return is the one which bears the bar code generated by the e-tailer, and thus is listed within the listing in the transaction history discussed in paragraph 28 lines 7 and 8 of Haseltine. The consumer

through its agent 42 is read as a causing a selection to be received by the association server 30 or bureau 44, the selection is read as the item, see, e.g. paragraph [0040], the selection of POKEMAN of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMAN devices for return. Because the selection is inputted into a computer, it is read as an "electronic selection".

5. once the server 30 receives the packing-slip information, it initiates by sending instructions for the return, the returns process.

Regarding the distinction of the step of displaying to a customer, the associate in Haseltine is read as the agent of the customer. Inherent to any position in a retail establishment is to allow an employee the use the services of the employer as a benefit of working of a given employer and thus the user could be the customer. Notwithstanding, Haseltine discloses the context of the user being the point of return associate 42 rather than the customer. However, Dodd does disclose a user as the customer and thus displays return information to the user and causes him to select a return process see, col. 98 lines 42 et seq. displayed to him for selection. It would be obvious to modify the method of Haseltine to include the user driven self return process of Dodd and to provide a selection step, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange etc.

Re claim 8: Haseltine disclose the problem with returns in that the customer and client may be separated by the entire breadth of the country making shipping for small products e.g. cookies (paragraph 0026) non cost effective. Thus it would be an obvious




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choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction.

Re claims 2-7, 9, 35-45 see above analysis.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number 571 272 6780.

  
Joseph A. Fischetti  
Primary Examiner  
Art Unit 3627  
**JOSEPH A. FISCHETTI  
PRIMARY EXAMINER**